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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,638	08/13/2001	Hiromichi Takada	212412US-2DIV	7996
22850	7590	12/12/2003	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			SILBERMANN, JOANNE	
		ART UNIT	PAPER NUMBER	3611

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	927638	Takada et al.
Examiner	Group Art Unit	
Silbermann	3611	

**—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—**

**Period for Response**

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on 9-22-03
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**Disposition of Claims**

- Claim(s) 5-8, 10-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 5-8, 10-13 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

**Attachment(s)**

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 6, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons, US #5,788,076.

3. Simmons teaches data code 70' (or 10') affixed to a package of fluid goods (Figure 1). Simmons does not specifically teach what information is included in the code, however, the particular indicia included on a label is considered to be entirely a matter of design choice. It would have been obvious to a person having ordinary skill in the art to place whatever indicia necessary on such a data label. Also, where the sole distinction set out in claims over prior art is in printed matter, there being no new feature of physical structure and no new relation of printed matter to physical structure, such claims may not be allowed. Ex parte GWENN, 112 USPQ 439 (BdPatApp&Int 1955). Additionally, patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. In re Montgomery, 102 USPQ 248 (CCPA 1954).

4. Claims 7, 8, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons in view of Doyle, UK application #2,240,205.

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5. Simmons does not teach a can having paint inside, however, this is old and well known in the art. Doyle teaches a can of paint having labels on the outside thereof. It would have been obvious to one of ordinary skill to apply a code label, as in Simmons, to the can of Doyle to provide information thereon.

6. The examiner also takes official notice of paint cans for sale with bar codes affixed to the outside thereof.

***Response to Arguments***

7. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

8. Applicant argues that the examiner did not consider all of the limitations of the claims, and that the data code has physical structure and the information thereon is not merely a matter of design choice.

9. In making the above rejection, the examiner has considered all of the claim limitations. The printed matter (the data code) has been considered, and it does not present a new and unobvious relationship between the printed matter and the substrate. It is understood that the specific instructions printed on the data code are not shown by the prior art, however, this is the only difference. As discussed above, where the sole distinction set out is in printed matter, such claims may not be allowed.

10. It is also understood that the data code has physical structure, for example, the ink, paper and backing material, however, there has not been shown any new and unobvious relationship between the printed matter and the substrate.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 703-308-2091. The examiner can normally be reached on Tu-Th 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Joanne Silbermann  
Primary Examiner  
Art Unit 3611

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